REMARKS

I. Status of the Claims

Claims 1-47 are currently pending.

II. Rejections Under 35 U.S.C. § 103

In the previous Office Actions, the Examiner rejected the pending claims as allegedly obvious over several references or combinations. The rejections, however, have been based on several fundamental legal and technical errors. A key error concerning the inherent disclosure of a genus is addressed below, and additionally in the context of the specific rejections.

1. A Genus Does NOT Inherently Teach or Suggest Every Species Therein

To date, the Examiner has failed to recognize the principle that a genus does not inherently teach or suggest all species contained therein.[1] This principle is relevant to the "aminated silicone," which is recited in claim 1 as "having an amine number greater than or equal to 0.4 meq/g."[2] Specifically, the Examiner has taken the position that the members of the aminated silicones genus, or at least all amodimethicones (a type of aminated silicone), inherently have an amine number of greater than or equal to 0.4 meq/g. (*See, e.g.,* Office Action of July 28, 2004 at 8.)

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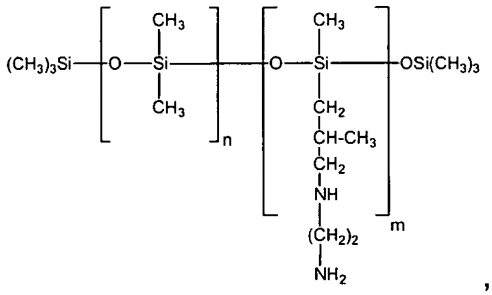
[1] *See, e.g., In re Meyer,* 202 USPQ 175 (CCPA 1979) (A reference disclosing "alkaline chlorine or bromine solution" embraces a large number of species and cannot be said to anticipate claims to "alkali metal hypochlorite."); *Akzo N.V. v. International Trade Comm'n*, 1 USPQ2d 1241 (Fed. Cir. 1986) (Claims to a process for making aramid fibers using a 98% solution of sulfuric acid were not anticipated by a reference which disclosed using sulfuric acid solution but which did not disclose using a 98% concentrated sulfuric acid solution.).

[2] As explained in the specification, "[t]he amine number is the number of amine milliequivalents per gram of compound." (Specification, pg. 9, ln. 7-8.)

Legally, the Examiner is not correct. As directed in MPEP § 2144.08(II)(A)(4), "Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus." *See also In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound."). The Examiner, however, has made no such determination.[3]

Factually, the Examiner is also not correct. For example, although claim 26 recites that the aminated silicone "having an amine number of greater than or equal to 0.4 meq/g" may be selected from, among other things, an amodimethicone having the formula  , this does not imply that all amodimethicones have the recited amine number.[4] Further, since the amine number of a species according to this generic formula depends on the relative proportions of monomers according to variables *n* and *m*, the disclosure of this or a similar generic formula

[3] As explained herein, the Examiner cannot factually support such a determination because the references do not provide any motivation to select undisclosed amodimethicones having any particular amine number, much less as claimed.

[4] According to this formula, the amine number is a variable related to the ratio of m/(n+m).

(without more) is not a teaching or suggestion of amodimethicones "having an amine number of greater than or equal to 0.4 meq/g."

Indeed, the present specification even provides several examples of amodimethicones that do not have having an amine number of greater than or equal to 0.4 meq/g.[5] For example, as shown on pages 22-23 of the present specification, Wacker's Finish WR 100 is an amodimethicone with an amine number of 0.15 meq/g, Wacker's Finish WR 1300 is an amodimethicone with an amine number of 0.3 meq/g, OSI's Silsoft TP 515 is an amodimethicone emulsion with an amine number of 0.058 meq/g, and Dow Corning's DC 939 is an amodimethicone emulsion with an amine number of <0.1 meq/g.

The Examiner's response has been that

> while Decoster does not explicitly state the amine number, since the [genus of amodimethicone] compounds being taught are the same as those recited in the instant claims, and since a compound and its properties are inseparable, the compounds of Decoster [inherently] have an amine number of greater than or equal to 0.4 meg/g.

(Office Action of July 28, 2004 at 8.) However, as explained above, the Examiner is incorrect to assert that "the compounds being taught are the same as those recited in the instant claims." The Examiner is also incorrect to conclude that "the [genus of amodimethicone] compounds of Decoster [inherently] have an amine number of greater than or equal to 0.4 meq/g." (Office Action of July 28, 2004, at 8.)

For at least these reasons, the present rejections, wherein no teaching, suggestion, or motivation is provided for using an animated silicone having an amine

[5] Obviously, if the Examiner were correct that all amodimethicones inherently had an amine number of greater than or equal to 0.4 meq/g, these examples would not exist.

number as claimed together with the other claimed elements, are in error and should be withdrawn.

2. Rejections under 35 U.S.C. § 103

a) Decoster

Claims 1-32, 34-41, and 43-46 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Decoster WO 97/46210, U.S. Pat. No. 6,451,747 ("Decoster") being relied upon by the Examiner as an English language translation. (Office Action of July 28, 2004, at 2-4.) Applicants respectfully traverse, based on the arguments of record and as further explained below.

The Examiner admits that Decoster does not recite, among other things, the instantly claimed amine number of the aminated silicones. (*E.g.*, Office Action of November 10, 2003, at 4.) Further, the Examiner has not provided (and cannot provide) any evidence or explicit teaching of the instantly claimed amine number. As explained above, despite the express evidence in the present specification on this issue, the Examiner has failed to appreciate that not all aminosilicones, and not all amodimethicones, necessarily have an amine number as recited in the present claims.

Additionally, rather than providing substantive response to the many other deficiencies in the rejections, the Examiner's responses are primarily limited to factually erroneous statements or the mere recitation of general legal concepts that do nothing to address or overcome the substantive deficiencies. This is neither proper nor helpful.

For example, on the issue of transparency, as recited in claim 1, the Examiner contends that the absence of any disclosure related to transparency in Decoster is "not persuavie" to traverse the rejection because

> consideration of a reference is not limited to preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art.

(Office Action of July 27, 2004 at 10.)[6] This principle is well and good as a general matter. However, its mere incantation does nothing to actually show that transparency, as claimed, is fairly taught or suggested to one of ordinary skill in the art.

Similarly, the Examiner has alleged that Decoster teaches that the aminosilicones are "interchangeable." (*E.g.*, Office Action of November 10, 2003, at 4.) First, this is not the case. For example, as disclosed in the present specification, the properties and effects of amodimethicones are not interchangeable. (*See, e.g.*, pg. 21-23, Example 2, where the transparency and other properties of exemplary shampoo compositions depend on the amine number of the aminated silicone.) Second, even if there was some recognized interchangeability, the Examiner has failed to cite or even allege any guidance (except for the present specification) addressing the selection of particular amine numbers, as would be required to support a rejection based on this theory. *See e.g.*, *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 USPQ 391 (Bd. Pat. App. & Inter. 1965); M.P.E.P. § 2144.

A similar set of substantively non-responsive comments were made by the Examiner concerning claim 43, which recites, among other things, that "said solvent is present in an amount ranging from 0.1 to 20% by weight relative to the total weight of

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[6] The Examiner's only other comment concerning this issues is the direction to "[s]ee the above rejections, wherein the transparency limitation is addressed." (Office Action of July 28, 2004 at 10.) However, transparency is not addressed elsewhere in the Office Action.

the composition." The Examiner has conceded that Decoster does not disclose the amount of solvent, and instead relies on general theories (without any underlying facts), such as "routine optimization." (Office Action of July 28, 2004 at 3.) In Applicants' Amendment dated June 22, 2004, the legal and technical flaws in the Examiner's attempted reliance on allegedly routine optimization and other arguments were conclusively addressed. However, the Examiner failed to meaningfully respond to the noted deficiencies.

For example, the Examiner's response that

> the instant independent claims do not require a solvent, let alone a specific amount of solvent

(Office Action of July 28 at 9) is not meaningful, as the Examiner is required to consider the dependent claims as well. The Examiner's further response that

> Decoster et al. themselves specifically teach broad formulations (i.e., liquid to cream), thereby implying that the amount of solvent is variable and within the skill of the artisan to adjust dependent on the type of cosmetic formulation the composition embodies.

(*id.*) is also not relevant. In particular, the alleged "skill of the artisan" is not a substitute for a teaching, suggestion, or motivation for the particularly claim solvent amount.[7]

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[7] The Examiner's further comments that

> the references are applied for what they make obvious to one of ordinary skill in the art and not what they exemplify,

and

> the test for obviousness is [what] the reference or combination of references makes obvious to one of ordinary skill in the pertinent art

(Office Action of July 28, 2004 at 9) are also non-responsive to the substantive absence of the required teaching, suggestion, or motivation for the claims solvent amounts.

For at least the aforementioned reasons and those of record, Applicants respectfully request withdrawal of this rejection.

b) Decoster further in view of Naito

Claims 33 and 42 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Decoster, and further in view of Naito at el. (U.S. Patent No. 5,476,649) ("Naito"). (Office Action of July 28, 2004, at 4-5.) The Examiner admits that Decoster lacks a teaching or suggestion of 18-methyl-eicosanoic acid and polyalkylene glycols. *Id.* The Examiner attempts to remedy these deficiencies by reliance on Naito. Applicants respectfully traverse.

First, since Naito has not been cited for and does not overcome the aforementioned deficiencies of Decoster, the reference combination taken together fails to establish a prima facie case of obviousness.

Second, in fashioning the present rejections, the Examiner has engaged in impermissible hindsight in an attempt to reconstruct the presently claimed invention based on piecemeal disclosures in the various references. For example, the Examiner has provided no evidence or teaching as to why 18-methyl-eicosanoic acid would be chosen from the broad disclosure of Natio. The basis of the Examiner's position is that "18-methyl-eicosanoic acid is specifically exemplified [in Natio]." (Office Action of July 28, 2004 at 10.) However, the fact that the Examiner can find a single component in the prior art is not a substitute for a teaching, suggestion, or motivation to select and use that particular compound in an entirely unrelated disclosure.

For at least these reasons and those of record, Applicants respectfully request the reconsideration and withdrawal of this rejection.

c) Decoster '211 in view of Hughes, and Decoster '211 in view of Hughes further in view of Naito

Claims 1-32, 34-41, and 43-47 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Decoster (English translation of WO 97/46211) ("Decoster '211") in view of Hughes, U.S. Patent No. 5,567,428 ("Hughes"). (Office action of July 28, 2004 at 5-7.) Claims 33 and 42 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Decoster '211 in view of Hughes further in view of Naito. (Office Action of July 28, 2004, at 7.) Applicants respectfully traverse.

The Examiner admits that Decoster '211 does not teach an aminated silicone with an amine number as claimed. The Examiner also does not cite Natio or Hughes for teaching or suggesting such an aminated silicone. While Applicants also disagree with the Examiner's rationale for combining these references, the combinations necessarily fail to establish a prima facie case of obviousness for at least the reason that not all the claimed elements, e.g., an amine number greater than or equal to 0.4 meq/g, are taught or suggested by the reference combination.

For at least the aforementioned reasons and those of record, Applicants respectfully request the reconsideration and withdrawal of these rejections.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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